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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,001

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Valerie Andre

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EXAMINER

KARPINSKI, LUKE E

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,001	<b>Applicant(s)</b> ANDRE ET AL.	
	<b>Examiner</b> LUKE E. KARPINSKI	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 7-10 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7-10, and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Receipt of amendments, arguments, and remarks filed 1/09/2009 is acknowledged.

### ***Claims***

Claims 1, 7-10, and 19-26 are currently pending.

Claims 2-6 and 11-18 are canceled.

Claims 21-26 are new.

Claims 1, 7-10, and 19-26 are under consideration in this action.

### ***Rejections***

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Maintained Rejections***

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**1. Claims 1, 7-10, 19, and 20 are rejected under 35 U.S.C. 103(a)** as being unpatentable over US Patent No. 6,409,995 to Habeck et al.

### ***Applicant Claims***

Applicant claims a liquid mixture consisting of a UV-A filter (diethylamino hydroxybenzoyl hexyl benzoate) and a UV-B filter (2-ethylhexyl 4-methoxycinnamate),

wherein said UV-A filter is present at 30-50% and said UV-B filter is present at 70-50% and said UV-A filter does not crystallize out.

Applicant further claims additional percentages for said filters and viscosities for said composition. Applicant further claims a process for preparing a cosmetic and pharmaceutical composition comprising mixing the composition of claim 1 with at least one oil phase.

***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

Hay beck et al. teach amino-substituted hydroxybenzophenones (col. 2, lines 17-67), specifically diethylamino hydroxybenzoyl hexyl benzoate (col. 17, table 2, no. 5) and 2-ethylhexyl 4-methoxycinnamate (col. 13, line 55 to col. 14, line 16) together as a component in cosmetic and pharmaceutical compositions (col. 11, lines 42-51), said UV-A filter present at 10-90% and 20-50% and said UV-B absorber present at 10-90 and 50-80% (col. 13, lines 47-54), said UV-A filter as a lesser amount than said UV-B filter (col. 11, lines 42-51), and said compositions in liquid form (col. 13, line 38) as claimed in claim 1.

Habeck et al. further teach said sunscreen mixtures as present in cosmetic and pharmaceutical formulations further comprising an oil phase (col. 11, lines 42-55) as claimed in claims 19 and 20.

***Ascertainment of the differences between the prior art and the claims***

***(MPEP 2141.01)***

Habeck et al. do not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, Habeck et al. do teach that said components may be formulated in the same composition at the claimed percentages.

Habeck et al. also do not teach the viscosities recited in claims 8-10.

***Finding of prima facie Obviousness Rational and Motivation***  
***(MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because Habeck et al. suggests that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Although Habeck et al. do not explicitly disclose a compositions consisting of diethylamino hydroxybenzoyl hexyl benzoate and 2-ethylhexyl 4-methoxycinnamate the reference does disclose a UV-A filter and a UV-B filter and Diethylamino hydroxybenzoyl hexyl benzoate and 2-ethylhexyl 4-methoxycinnamate are both specifically named.

Regarding the limitations of viscosities; Habeck et al. teach compositions which are materially the same as those claimed. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911

F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Further, the compositions of Habeck et al. would also be fluid compositions and the UV-A filter would not crystallize out for the same reasons as above.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Response to Arguments***

Applicant's arguments filed 1/09/2009 have been fully considered but they are not persuasive.

Applicant argues that Habeck et al. teach 13 possible compounds for component A and 32 possible compounds for component B.

This argument is not found persuasive because Habeck et al. also teach the combination of the instantly claimed component A and B.

Applicant also argues that Habeck et al. are silent to several physical properties of N-hexyl 2-(4-diethylamino-2-hydroxybenzoyl)benzoate.

This argument is not found persuasive because Habeck et al. teach said compound; it is not a requirement that prior art teach all properties of all compounds.

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Applicant also argues that Habeck et al. do not teach the claimed percentages of UV components A and B, and cite a passage describing the amount of said components within the overall composition.

This argument is not found persuasive because the examiner reads Habeck et al. as teaching the sunscreen components as a separate composition, apart from the final cosmetic composition. Said separate sunscreen composition consists of 10-90%, preferably 20-50% component A, and therefore 10-90% and preferably 50-80% component B. Said separate composition is present at up to 10% of different cosmetic formulations, however, the examiner is utilizing the separated sunscreen composition consisting of components A and B in the instant rejection. The percentages of Habeck et al. read on the instantly claimed percentages and therefore make obvious the instantly claimed invention.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 103***

**2. Claims 21-26 are rejected under 35 U.S.C. 103(a)** as being unpatentable over US Patent No. 6,409,995 to Habeck et al.

### ***Applicant Claims***

Applicant claims the compositions of claim 7 having a viscosity of 300-500 mPa\*s, a process of preparing a cosmetic and a pharmaceutical comprising mixing the



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composition of claim 21 with a carrier comprising an oil phase, formulas and percentages of the components of said compositions, an antioxidant, specifically vitamin E and percentages thereof.

***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

The teachings of Habeck et al. are delineated above and incorporated herein.

In particular Habeck et al. teach said compositions in several forms, including liquid (col. 13), as pertaining to claim 21, said formulations as liquids, with a carrier comprising as oil (col. 11 and 13), as pertaining to claims 22 and 23, said compositions consisting of components having structures of formula I and II (col. 13), as pertaining to claim 24, antioxidants present at 0.001-30% and vitamin E present at 0.01-10% (col. 13), as pertaining to claims 25 and 26.

***Ascertainment of the differences between the prior art and the claims  
(MPEP 2141.01)***

Habeck et al. do not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, Habeck et al. do teach that all of said components may be present within a composition at the claimed percentages.

***Finding of prima facie Obviousness Rational and Motivation  
(MPEP 2142-2143)***

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It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because Habeck et al. suggest that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Regarding the viscosity limitation of claim 21, Habeck teach said compositions in several different forms, including liquid, paste, solid, lotion, gels, and creams, all of which have widely varying viscosities. It would have been well within the capabilities of one of ordinary skill in the art to produce said formulations with any desired viscosity, including from 300-500, which is more viscous than water but not quite as viscous as a lotion, which is read on by Habeck et al. teaching of said formulations being in liquid form.

Regarding claim 24 and the consisting essentially of language, Habeck et al. teach sunscreen compositions as 10-90% component A and 10-90% component B, this separate composition is taught to be added to cosmetic compositions at percentages of up to 10%. The examiner is utilizing the sunscreen composition in the present rejection not the entire cosmetic formulation.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

***Conclusion***

Claims 2-6 and 11-18 are canceled.

Claims 1, 7-10, and 19-26 are rejected.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/  
Primary Examiner, Art Unit 1616